

Response
Applicants: Rudy Mazzocchi et al.
Serial No.: 10/051,648

Attorney Docket: MVA1001USC6

REMARKS

This is responsive to the outstanding Office Action issued December 10, 2004. Claims 1 - 126 are pending. Claims 53 - 126 are withdrawn from examination as non-elected. No claims are canceled. No claims are amended. Claims 49 - 52 are allowed.

Applicant, Richard S. Kusleika, and Applicant's representative, Terry L. Wiles, thank Examiner Vy Q. Bui for the courtesy of a personal interview on February 3, 2005. At the interview a demonstration of the use of a guidewire and a balloon catheter to track over the guidewire was performed by Richard Kusleika, a representative of ev3 Inc., the assignee of the present invention. At the interview the differences between the claimed invention and the prior art were discussed and are set forth below. The present Amendment and Response is a *bona fide* effort to advance this application to issue.

Information Disclosure Statements

Applicants note that the Examiner did not initial and date several references listed on Forms PTO-1449 submitted with Information Disclosure Statements to confirm that all cited references have been considered in the prosecution of this application.

Regarding the Information Disclosure Statement filed March 18, 2004, the International Search Report for Counterpart Canadian Application No. 2,194,671 (1 page) and the Partial English language translation of JP 44 20599 (1 page) were not initialed and dated as considered by the Examiner. Regarding the Information Disclosure Statement filed January 18, 2002, the Search Report for counterpart International Application (PCT/US95/08613) were not initialed and dated as considered by the Examiner.

Applicants request that the Examiner initial, date and return to Applicants copies of the Forms PTO-1449 confirming that the Examiner has considered all cited documents. If the Examiner did not receive copies of these references, Applicants request that the Examiner so state and Applicants will submit copies for the Examiner's consideration.

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Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) and required that “a drawstring/a peripheral edge,” recited in claims 45 – 48, must be shown in the drawings or the features canceled from the claims. Applicants submit that the tethers 290 in FIGS. 11 and 12 illustrate a drawstring, which is further described at page 34, line 28 to page 35, line 10, *inter alia*. Applicants submit that the proximal lip 286 in FIGS. 11B and 12B and the proximal lip 328 in FIGS. 14 and 15 illustrate a peripheral edge, *inter alia*. Withdrawal of this ground of objection and acceptance of the drawings is requested.

Objection to the Claims

The Examiner objected to claims 45 – 48 because the drawings supposedly did not show certain features of these claims, specifically, “a drawstring/a peripheral edge.” With the remarks above confirming that the drawings do show these features, Applicants submit that these claims are in condition for allowance.

Rejection Under 35 U.S.C. § 102

Claims 1, 3, 5 – 14, 16 – 20, 22, 23, 25, 27 – 36, 38 – 42 and 44 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,926,858 to Gifford, et al. (“Gifford”). Applicants traverse this rejection. A sustainable rejection under 35 U.S.C. § 102(b) requires that a single reference disclose all elements recited in the rejected claims.

Gifford does not meet the requirements of independent claims 1, 22, 23 and 44, which require a “retraction member (tether) having ... a proximal end connected (attached) to the guidewire (carrying means) ...” Specifically, the proximal half of the Gifford basket 20, 120 does not have its proximal end 24, 124 connected or attached to the structure identified by the examiner as the “guidewire” 25, 125. Element 125 is actually referred to in Gifford as being the “proximal bottom end 125 of collection chamber 114” and not as a wire or guide wire. The proximal end 24 of the proximal half of the Gifford basket 20 (FIGS. 1 – 5) connects or attaches to the hypo tube (“guide wire”) 8 through which the guidewire 25 (referred to in Gifford as an “extension wire”)

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passes. The proximal end 124 of the proximal half of the Gifford basket 120 fits and slides over the guide wire 108 (Gifford, FIGS. 8 and 9, col. 8, lines 41+). Neither of these embodiments identified by the examiner discloses the limitations of these claims. In the embodiment of FIGS. 1 – 5 of Gifford the proximal end 24 is not attached to the structure identified by the examiner as comprising a guide wire (expansion wire 25). The proximal end is actually connected to a hypo tube/guide wire 8. Further, if the hypo tube/guide wire 8 is considered to be a guidewire as recited in the claims this embodiment still does not anticipate these claims since they require that the guidewire/carrying means extend to at least a distal end of the filter. Hypo tube/guidewire 8 terminates at proximal end 24. Therefore, the embodiment of FIGS. 1 – 5 of Gifford does not anticipate these claims. Further, the embodiment disclosed in FIGS. 8 and 9 of Gifford does not anticipate the claims because proximal end 124 does not connect to any structure which could comprise a guidewire.

Dependent claims 3, 5 – 14, 16 – 20, 25, 27 – 36 and 38 – 42 add further patentable limitations that further distinguish over Gifford. Accordingly, this rejection of claims 1, 3, 5 – 14, 16 – 20, 22, 23, 25, 27 – 36, 38 – 42 and 44 is unsupported and must be withdrawn.

Rejection Under 35 U.S.C. § 103

Claims 2, 4, 15, 21, 24, 26, 37 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gifford. This rejection does not set forth a sustainable finding of obviousness for these claims and is traversed.

The remarks concerning Gifford in the previous rejection are repeated here as equally pertinent. The issue of whether or not Gifford discloses or makes obvious the use of Nitinol does not overcome the deficiencies in Gifford noted above. Accordingly, this rejection of claims 2, 4, 15, 21, 24, 26, 37 and 43 must be withdrawn as unsupported.

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CONCLUSION

In view of Applicants' remarks above, claims 1 – 52 are submitted to be in condition for allowance. If the only matter remaining prior to the issuance of a Notice of Allowance is the presence of non-elected claims 53 – 126, the Examiner is authorized to cancel these claims by Examiner's Amendment and Applicants reserve the right to represent these claims in a divisional application.

If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

Date: 3/4/05

By


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